



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/662,700

09/15/2003

Babak Damaghi

34294/3

1032

1912

7590

11/17/2009

AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 PARK AVENUE
NEW YORK, NY 10016

EXAMINER

LAstra, DANIEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

11/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/662,700	Applicant(s) DAMAGHI, BABAK	
	Examiner DANIEL LASTRA	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6 and 8-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3688

1. Claims 1, 4, 6 and 8-18 have been examined. Application 10/662,700 (ENHANCED METHOD OF RADIO AND TV ADVERTISING) has a filing date 09/15/2003.

Response to Amendment

2. In response to Non Final Rejection filed 04/13/09, the Applicant filed an Amendment on 07/13/09, which amended claims 1, 8, 15-18.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4, 6 and 8-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transforms a particular article to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to a particular machine or apparatus nor transforms a particular article to a

Art Unit: 3688

different state or thing. "Broadcast media" is not an apparatus as it is defined in Applicant's specification as the Internet (see Applicant's specification paragraph 14).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6 and 8-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Llenas (US 5,271,626).

Claim 1, Llenas teaches:

A method of advertising within a media broadcast program which features regular program content and content related to commercials, comprising:

A. establishing a contest whereby listeners of said program may become participants in said contest by following procedures of said contest, said contest including the broadcast of clues using broadcasting media from time to time at least partially during the broadcast of one of said commercials, with the contest requirement that a participant respond to said at least one broadcasted clue and follow the required procedure of said contest (see figure 4b; col 1, line 5 – col 3, line 60),

B. broadcasting using the broadcast media at least one set of regular program content during said program (see figure 4b; col 1, line 5 – col 3, line 60),

C. broadcasting using the broadcast media at least one commercial during said program as part of the content related to commercials (see figure 4b; col 1, line 5 – col 3, line 60).

D. broadcasting using the broadcast media at least one clue at least partially during said at least one commercial as part of the content related to commercials (see figure 4b; col 1, line 5 – col 3, line 60), and

E. providing a specified award to each participant whose response to said clue satisfied the contest requirements to win said award (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 4, Llenas teaches:

wherein said at least one clue is incorporated into a commercial (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 6, Llenas teaches:

broadcasting at least two separate sets of songs, and broadcasting at least one commercial following each of said sets of songs, and broadcasting at least one clue at least partially during the at least one of said commercials (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 8, Llenas teaches:

A method of advertising within a media broadcast program which features regular program content and content related to commercials comprising:

A. establishing a contest whereby listeners of said program may become participants in said contest by following procedures of said contest, said

Art Unit: 3688

contest including the broadcast of clues using broadcasting media from time to time at least partially during broadcast of one of said commercials, with the contest requirement that a participant respond to said at least one broadcasted clue and follow the required procedure of said contest (see figure 4b; col 1, line 5 – col 3, line 60),

B. broadcasting using the broadcast media at least one set of regular program content during said program (See figure 4b),

C. broadcasting using the broadcast media at least one set of commercials during said program as part of the content related to commercials (see figure 4b)

D. broadcasting using the broadcast media at least one clue at least partially during said at least one set of commercials as part of the content related to commercials (see col 2, lines 45-65; col 7, lines 50-60) and

E. providing a specified award to each participant whose response to said clue satisfied the contest requirements to win said award (see figure 4b; col 1, line 5 – col 3, line 60),

Claim 9, Llenas teaches:

wherein the at least one set of regular program content comprises at least two songs, and each of said sets of commercials comprises at least two commercials (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 10, Llenas teaches:

wherein a typical one of said sets of regular program content is broadcast for about ten minutes, and a typical one of said sets of commercials is broadcast for about two minutes (see figure 4b; col 1, line 5 – col 3, line 60).

Art Unit: 3688

Claim 11, Llenas teaches:

wherein said award comprises a specific prize (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 12, Llenas teaches:

wherein said award comprises the right to participate in a further phase of said contest (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 13, Llenas teaches:

wherein said response required of a contest participant comprises placing a call to a specified phone number (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 14, Llenas teaches:

wherein said response to win the contest comprises being the nth caller of a plurality of callers, where n is a number specified in the contest procedure (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 15, Llenas teaches:

Conducting a contest within a media broadcast program which features regular program content and content related to commercials, comprising:

A. establishing said contest whereby listeners of said program may become participants in said contest by following procedures of said contest, said contest including the broadcast of clues using broadcasting media from time to time at least partially during broadcast of one of said commercials, with the contest requirement that a participant respond to said at least one broadcasted clue and follow the required procedure of said contest (see figure 4b; col 1, line 5 – col 3, line 60),

Art Unit: 3688

B. broadcasting using the broadcast media at least one set of regular program content during said program (see figure 4b),

C. broadcasting using the broadcast media at least one set of commercials during said program as part of the content related to commercials (see col 2, lines 45-65; col 7, lines 50-60);

D. broadcasting using the broadcasting media at least one clue at least partially during a commercial of said at least one set of commercials (see col 2, lines 45-65; col 7, lines 50-60), and

E. providing a specified award to each participant whose response to said clue satisfied the contest requirements to win said award (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 16, Llenas teaches:

A method of advertising within a media broadcast which features the broadcast of regular program content for a first specified period of time and broadcasting content related to commercials during second specified period of time, comprising:

A. establishing a contest whereby listeners or viewers of said program may become participants in said contest by following procedures of said contest, said contest including the broadcast of at least one clue using broadcast media from time to time at least partially during broadcast of at least one of said commercials with the contest requirement that a participant respond to said at least one broadcasted

Art Unit: 3688

clue and follow the required procedure of said contest (see figure 4b; col 1, line 5 – col 3, line 60),

B. broadcasting using the broadcast media said program during the first specified period of time (see figure 4b)

C. broadcasting using the broadcast media at least one set of commercials during said second specified period of time (see figure 4b),

D. broadcasting using the broadcast media said at least one clue at least partially during a commercial of said at least one set of commercial, (see col 2, lines 45-65; col 7, lines 50-60), and

E. providing a specified award to each participant whose response to said clue satisfied the contest requirements to win said award (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 17, Llenas teaches:

A method of advertising within a media broadcast program which features regular program content and content related to commercials comprising:

A. establishing a contest whereby listeners of said program may become participants in said contest by following procedures of said contest, said contest including the broadcast using broadcast media of triggering events from time to time, with the contest requirement that a participant respond to said at least one broadcasted triggering event and follow the required procedure of said contest (see figure 4b; col 1, line 5 – col 3, line 60),

B. establishing as one rule of said contest that said triggering event will be the broadcast of a particular commercial as part of the content related to commercials (see figure 4b)

C. broadcasting using the broadcast media at least one set of regular program content during said program (see figure 4b),

D. broadcasting using the broadcast media at least one of said particular commercials during said program as part of the content related to commercials (see col 2, lines 45-65; col 7, lines 50-60);

E. providing a specified award to each participant whose response to said triggering event satisfied the contest requirements to win said award (see figure 4b; col 1, line 5 – col 3, line 60).

Claim 18, Llenas teaches:

A method of advertising within media broadcast which features the broadcast of regular program content for a first specified period and broadcasting content related to commercials during a second specified time period comprising:

A. establishing a contest whereby listeners or viewers of said program may become participants in said contest by following procedures of said contest, said contest including the broadcast of at least one triggering event using broadcast media from time to time, with the contest requirement that a participant respond to said at least one broadcasted triggering event and follow the required procedure of said contest (see figure 4b; col 1, line 5 – col 3, line 60)

B. establishing as one rule of said contest that said triggering event will be the broadcast of a particular commercial as part of the content related to commercials during the second specified time period (see col 2, lines 45-65; col 7, lines 50-60)

C. broadcasting using the broadcast media said regular program content for the first specified period of time (see col 2, lines 45-65; col 7, lines 50-60);

D. broadcasting using the broadcast media said at least one of said particular commercials which is said triggering event during the second specified time period (see col 2, lines 45-65; col 7, lines 50-60)

E. providing a specified award to each participant whose response to said triggering event satisfied the contest requirements to win said award (see figure 4b; col 1, line 5 – col 3, line 60).

Response to Arguments

5. Applicant's arguments filed 07/13/09 have been fully considered but they are not persuasive. The Applicant argues that Llenas does not teach Applicant's claimed invention, because according to the Applicant, Llenas does not teach that clues are provided at least partially during a commercial. The Examiner answers that Llenas teaches announcing a clue (i.e. address) during one of the commercials so the commercial is the clue (see col 2, lines 30-45) and that clues are provided at least partially during a commercial in the fade-to-black periods at the ends of many commercials (see col 4, lines 55-60; col 7, lines 50-65). Therefore, contrary to Applicant's argument, Llenas teaches Applicant's claimed invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT A WEINHARDT can be reached on (571)272-6633. The official Fax number is (571) 273-8300.

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Primary Examiner, Art Unit 3688
November 10, 2009